

REMARKS/ARGUMENTS

This Response is being submitted in response to the Office Action dated December 14, 2006, as supplemented by an Office Action dated February 2, 2007. Claims 11-15, 19-26, and 28-32 were pending in this application prior to this Response and claims 11-15, 19-26, and 28-32 stand rejected. Claims 1-10 and claims 16-18 and 27 were previously canceled. Reconsideration and reexamination are respectfully requested.

Rejections Under 35 U.S.C. § 112, first paragraph

Claims 11, 12, 13, 15, 19, 20, 21, 23, 24, 25, 30, and 31 stand rejected under 35 USC §112, first paragraph, in that the specification purportedly does not enable any person skilled in the art to make and practice the invention, and as purportedly failing to comply with the written description requirement. Specifically, the Examiner has stated that claims 11, 12, 13, 15, 19, 20, 21, 23, 24, 25, 30, and 31 stand rejected because the specification allegedly does not enable one skilled in the art to which the claims pertain to make and practice the invention commensurate in scope with these claims. Furthermore, the Examiner stated that claims 11, 12, 13, 15, 19, 20, 21, 23, 24, 25, 30, and 31 stand rejected because the claims contain subject matter not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention commensurate in scope with the claimed inventions; and furthermore, that "(t)he expression **"root extract"** does not define the ingredients. Applicants respectfully traverse this rejection for at least the reasons discussed below.

The application adequately enables one skilled in the art to make and practice the invention. The extraction process is described in the preferred embodiment section of the initial patent filing. Specifically, the description sets forth the steps of placing Kaempferia Galanga root in an alcohol bath, heating in the alcohol bath to extract the cinnamate from the root, separating the alcohol solution from the root residue, and thereafter heating the alcohol extract for a time sufficient to evaporate substantially all of the alcohol therefrom. Therefore, one skilled in the art can follow the steps to obtain the end product of the extraction process.

The result of the extraction process is a definite product, which thus is clearly enabled. Applicants have thus satisfied the enablement requirement of section 112. Applicant's use of the term "root extract" throughout the application is definite, based on the definition of "root extract" early on in the application, particularly as defined by the process for extraction which results in a definite product.

Moreover, since a definite product is obtained by this disclosed process, Applicant has also satisfied the written description requirement of section 112. Applicants did have possession of the claimed invention, as they had defined an extract by at least one definite extraction process. Persons of skill in the art are also put on notice as to the definition of an extract by the recitation of this extraction process.

Applicants thus stand by their prior argument, incorporated herein as if fully set forth, that "those skilled in the art would understand what is claimed when the claim is read in light of the specification."

In this case, the structure of the initial application disclosure provides instructions for one skilled in the art to obtain "root extract" of *Kaempferia Galanga*. Despite examiner's listing of other elements that may be found in *Kaempferia Galanga*, it is peripheral to this application to discuss other ingredients. As the application sets forth, any other compounds may be present in *Kaempferia Galanga* may be found in the root extract; however, they are defined by the extraction process and thus enabled and sufficiently described.

As to vagueness and indefiniteness, the examiner imposes the requirement that the applicant indicate in the claims the structure of the ingredient(s) or the compound(s) and the number of compound(s) effective for the claimed composition or a sufficient number of physical data to define the compound(s) or to submit a product-by-process for claimed "root extract". Applicant has complied with the statutory requirement. The structure of the root extract is understood by reference to the art and the specification and thus neither indefinite nor vague. ingredient is ethyl p-methoxycinnamate. The number of compounds effective for the claimed composition is of no matter; an extract as described hereby is effective regardless how many constituent elements may contribute.

Converse to the examiner's assertion that the term "root extract" does not define the ingredients, the extraction process defines the expression "root extract". Applicant has previously stated that use of the term "extract" is common in patent

lexicography relating to derivatives of organic matter, as evidenced by the patents and prior art listed in the brief summary of the invention section of the initial patent filing. Use of the term "extract" does not render the claims of a patent indefinite or vague, as often the term "extract" may be the most accurate and complete means of describing a constituent and essential ingredient of the claimed invention. This may be true here, where it may be incomplete to refer to the identity of the effective ingredients without making reference to the means of derivation from a root.

Applicants submit that the terms "extract" and "root extract" and its further definition in the disclosure and in claim 14 are definite for at least the above reasons. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 11, 12, 13, 15, 19, 20, 21, 23, 24, 25, 30, and 31, and respectfully request that the claims be allowed.

Rejections Under 35 U.S.C. § 102(b)

Claims 11, 12, 14, 15, 19, 20, 21, 22, 24, 25, 26, 28, 30, 31 and 32 stand rejected under 35 USC § 102(b) as purportedly being anticipated by Voss et al. (U.S. Patent No. 5,972,315; hereinafter "Voss"). Specifically, the Examiner has rejected these claims, "...in view of Example 1b, wherein the concentration of the ethyl p-methoxycinnamate is 2%." Claims 11, 12, 14, 15, 19, 20, 21, 22, 23, 24, 25, 26, 28, 30, 31 and 32 stand rejected under 35 USC § 102(b) as purportedly being anticipated by JP40815734 (hereinafter "Matsuda") in view of paragraphs 26, 29, 31, 41-43 and 49 of that patent, which allegedly contain extracts of the claimed plant material within the scope of the claimed percentages. Finally, claims 11-13, 15, 19-21, 23, 25 and 31 stand rejected under 35 USC § 102(b) as purportedly being anticipated by Schade, DE 19849514 (hereinafter "Schade"), which allegedly teaches isoamyl p-methoxycinnamate which is within the scope of the claimed inventions. Applicants respectfully traverse this rejection for at least the reasons discussed below.

Applicants' claim 11 recites:

A composition for protecting mammalian skin from discoloration or harmful effects of tyrosinase or chemically induced irritation other than UV radiation consisting essentially of an effective amount of up to about 5% by weight of a root extract of *Kaempferia Galanga*.

Applicants' claim 21 recites:

A composition for protecting mammalian skin from discoloration or harmful effects of tyrosinase or chemically induced irritation other than UV radiation comprising a preparation containing, in weight percent, an effective amount up to about 5 percent of a root extract of Kaempferia Galanga dispersed in a carrier.

Applicants' claim 26 recites:

A composition for protecting mammalian skin from discoloration or the harmful effects of tyrosinase or chemically induced irritation other than UV radiation comprising a preparation containing, in weight percent, an effective amount up to about 5 percent of ethyl p-methoxycinnamate dispersed in a carrier; wherein the ethyl p-methoxycinnamate is extracted from Kaempferia Galanga root.

Applicants' specification and claims disclose and teach the use of the skin-care product, or the components thereof, for protecting against the harmful effects of tyrosinase or chemically induced irritation other than UV radiation, as taught by Applicants' independent claims 11, 21 and 26. Conversely, Voss limits description of its skin-care product throughout to "a new cosmetic skin-care product against ageing of the skin as an effect of light", as in col. 1, line 1; col. 1, line 55; and col. 2, line 27. By limiting the Voss cosmetic skin-care product to one function, Voss specifically does not include the element claimed and taught by Applicant, which is protection against the harmful effects of tyrosinase or chemically induced irritation other than UV radiation.

Furthermore, the only mention of ethyl p-methoxycinnamate in Voss is in col. 4, line 47. The inclusion of ethyl p-methoxycinnamate, to the extent it is mentioned in this one instance, is as a UV B filter in the amount of 2.0 g in a total emulsion of 100 g. Voss limits inclusion of ethyl p-methoxycinnamate to this one Example 1b, and furthermore, limits the role of ethyl p-methoxycinnamate to the role of a UV B filter at a 2.0% concentration. By such limitation, Voss does not include the "other than UV limitation" of Applicants' claims and moreover, teaches away from use of ethyl p-methoxycinnamate as anything but a UV B filter in a 2.0% concentration. Applicants' composition's use of Kaempferia Galanga root extract serves an entirely different function than the Voss composition. Applicants' composition teaches use of Kaempferia Galanga root extract as protection against the harmful effects of

tyrosinase or chemically induced irritation but specifically does not include Kaempferia Galanga root extract as a protectant against UV radiation.

The examiner appears to state that the products are identical or substantially identical, and to require that the applicant prove that the prior art products do not inherently possess the characteristics of the claimed product. In re Brown, 459 F.2d 531 (CCPA 1972). As a preliminary matter, the products are different. Voss requires that its UV-protectant composition contain at least three elements (see Claim 1). Applicant only requires one ingredient and possibly a carrier. Therefore, the products are not identical or substantially identical. Furthermore, the claimed product here is specifically intended for "protecting mammalian skin from discoloration or the harmful effects of tyrosinase or chemically induced irritation other than UV radiation". This is not an inherent characteristic of the Voss product, which "is based on UV-radiation-absorbing substances [necessarily] in combination with a free-radical scavenger system".

Similarly, the Matsuda patent is entitled "UV Absorptive Skin Cosmetic", and is described as "a UV absorptive skin cosmetic characterized by having high safety and comprising a plant extract having UV absorptive effect". The objective of the invention in Matsuda is to protect the skin against harmful UV light, unlike the objective of applicant's patent. Matsuda is a UV protectant. Applicants' invention is a non-UV protectant. These are not identical and thus Matsuda does not anticipate.

The Schade patent, to the best of applicant's understanding, references neither extract of Kaempferia Galanga nor a non-UV protectant. The reference cited by the examiner is isoamyl p-methoxycinnamate, also known as amiloxate. The mere fact that the Schade reference teaches a UV protectant for a potential substituent of Kaempferia Galanga root extract does not teach or suggest the root extract itself nor as an "other than UV" protectant. Therefore, the Schade patent does not constitute disqualifying prior art.

In order to sustain a rejection under 35 USC 102(b), the cited reference (i.e. Voss, Matsuda, and Schade) must teach or disclose each and every element of the claimed invention. None of the cited references teaches each and every element of Applicants' amended claims 11, 21 and 26. Applicants' claims 11, 21 and 26 are

believed to be allowable over Voss, Matsuda and Schade. Applicants' dependent claims 12-15, 19, 20, 22-25 and 28-30 are believed to be allowable over Voss, Matsuda and Schade because they depend from allowable independent claims 11, 21 and 26.

Rejections Under 35 U.S.C. § 103(a)

Claims 13, 23, 28 and 29 stand rejected under 35 USC 103(a) as purportedly being obvious over Voss et al. (U.S. Patent No. 5,972,315; hereinafter "Voss"). Specifically, the Examiner has rejected these claims, "...in view of Example 1b, wherein the concentration of the ethyl p-methoxycinnamate is 2% further in view of the disclosure which teaches that the percentage range is as low as 0.1%..." Claims 11-15, 19-26 and 28-32 stand rejected under 35 USC 103(a) as purportedly being obvious over Matsuda. Specifically, the Examiner has rejected these claims, "...in view of the broad disclosure as noted by the abstract as well as the examples noted . . . which extracts contain at least the ethyl p-methoxycinnamate in the extract." Applicants respectfully traverse this rejection for at least the reasons discussed below.

Applicants incorporate their above arguments with regard to Voss, *supra*, and Matsuda, *supra*, and submit that Applicants' amended claims 13, 23, 28 and 29 are believed to be allowable at least, because: i) they contain limitations not taught or suggested by Voss or Matsuda; and ii) they depend from allowable independent claims 11, 21 and 26, respectively.

CONCLUSION

Applicants respectfully request that all rejections be obviated or traversed hereby and withdrawn. A timely Notice of Allowance is requested to be issued in this case. Applicants believe no fees or petitions are due with this filing. However, should any such fees or petitions be required, please consider this a request therefore and authorization to charge Deposit Account No. 02-2093 as necessary.

Dated: May 2, 2007.

Respectfully submitted,

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